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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/084,502

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Masahiro Tada

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06/30/2006

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER

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EXAMINER

HASHEM, LISA

ART UNIT

PAPER NUMBER

2614

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/084,502	TADA ET AL.	
	Examiner	Art Unit	
	Lisa Hashem	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4, 6-8 and 12 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 9-11 is/are rejected.
- 7) ☒ Claim(s) 8-11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/30/03; 6-14-04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Office Action filed on 11-23-2005 is vacated on the grounds that U.S. Patent Application Publication No. 2003/0078002 by Sanjeev et al is not considered prior art based on the filing date of the instant application, see Examiner Interview, filed 1-11-2006. Therefore, the Final Rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made.
2. The response to the Examiner Interview filed 1-11-2006 is a Non-Final Office Action and is set forth below. Please disregard the Office Action filed on 11-23-2005.

Drawings

3. The drawings are objected as cited in the last Non-Final Office Action filed on 5-20-2005.

Claim Objections

4. Claim 8 recites the limitation " the predetermined period ". There is insufficient antecedent basis for this limitation in the claim.
5. Claim 9 recites the limitation "the predetermined functions". There is insufficient antecedent basis for this limitation in the claim.
6. Claim 10 recites the limitation "the disconnection discriminating conditions". There is insufficient antecedent basis for this limitation in the claim.
7. Claim 10 recites the limitation "so that the predetermined functions between the communication device and the target communication terminal can be performed when the disconnection discriminating conditions are satisfied". Examiner assumes the limitation should read 'so that the predetermined functions between the communication device and the target

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communication terminal can not be performed when the disconnection discriminating conditions are satisfied'. Appropriate action is required.

8. Claim 11 recites the limitation "the predetermined functions". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 3 and 9 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent No. 6,633,757 by Hermann et al, hereinafter Hermann.

Regarding claim 3, Hermann discloses a radio communication device or service-consuming device (col. 6, lines 52-67) (Fig. 1A; Fig. 1B) in a network for communicating with a target communication terminal or service-providing device (col. 6, lines 52-67) (Fig. 2A; Fig. 2B) in the network (col. 6, lines 17-46; col. 12, line 58 – col. 14, line 29), comprising:
a service information memory configured to store service information so that predetermined functions can be performed with the target communication terminal (col. 13, line 66 - col. 14, line 27);
a registration module (Fig. 1A, 11) configured to register communication controlling information that defines discriminating conditions (e.g. distinguish service-providing devices within the radio communication device's adjacency) for establishing a new connection with the target

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communication terminal or disconnecting an existing connection with the target communication terminal (col. 8, line 58 – col. 9, line 27; col. 13, lines 42-65); and

a communication control module or CPU (Fig. 1A, 17) configured to communicate with the target communication terminal by using the service information read out from the service information memory based on the communication controlling information (col. 13, lines 33-51).

Regarding claim 9, Hermann discloses a method for controlling a communication device or service-consuming device (col. 6, lines 52-67) (Fig. 1A; Fig. 1B) that exchanges data with a target communication terminal or service-providing device (col. 6, lines 52-67) (Fig. 2A; Fig. 2B) over a radio network when establishing a new radio communication connection between the communication device and a target communication terminal (col. 6, lines 17-46; col. 12, line 58 – col. 14, line 29), the communication device having a memory for storing various types of data (col. 13, line 66 - col. 14, line 27), the method comprising:

judging whether predetermined connection discriminating conditions (e.g. distinguish service-providing devices within the radio communication device's adjacency) are satisfied by repeating a target communication terminal discovery process before performing predetermined functions (col. 8, line 58 – col. 9, line 27; col. 13, lines 42-65); and

performing the predetermined functions through the radio communication connection by extracting required service information from memory to perform the predetermined functions between the communication device and the target communication terminal,

the required service information is stored in the memory by executing the predetermined functions with the target communication when the predetermined connection conditions are satisfied (col. 13, lines 33-51; col. 13, line 66 - col. 14, line 27).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1, 2, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hermann.

Regarding claim 1, Hermann discloses a radio communication device or service-consuming device (col. 6, lines 52-67) (Fig. 1A; Fig. 1B) on a network for communicating with a target communication terminal or service-providing device (col. 6, lines 52-67) (Fig. 2A; Fig. 2B) on the network (col. 6, lines 17-46; col. 12, line 58 – col. 14, line 29), comprising:

- a memory configured to store service information so that predetermined functions can be performed over the network with the target communication terminal (col. 13, line 66 - col. 14, line 27);
- a judging module (Fig. 1A, 11) configured to judge whether predetermined connection conditions (e.g. distinguish service-providing devices within the radio communication device's adjacency) with the target communication terminal are satisfied by repeating a target communication terminal discovery process (col. 8, line 58 – col. 9, line 27; col. 13, lines 42-65);
- and
- a communication control module or CPU (Fig. 1A, 17) configured to execute the predetermined functions with the target communication terminal by reading service information associated with

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the target communication terminal from the service information memory when the predetermined connection conditions are satisfied (col. 13, lines 33-51).

Hermann clearly discloses a radio communication device communicating with a target communication terminal. However, Hermann does not disclose establishing radio communication with another target communication terminal.

Hermann discloses judging whether predetermined conditions with the target communication terminal are satisfied with the target communication terminal by repeating a target communication terminal discovery process before establishing radio communications with another target communication terminal. Wherein, if the target communication terminal is not within the same area as the radio communication device, another target communication terminal or service-providing terminal will be sought to execute predetermined functions within the same vicinity of the radio communication device (col. 3, line 60 – col. 5, line 25; col. 8, line 19 – col. 9, line 27; col. 11, lines 63-67).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the method of Hermann to include repeating a discovery process before establishing radio communications with another target communication terminal. One of ordinary skill in the art would have been lead to make such a modification to allow the radio communication device to establish communications with another target communication terminal when it is determined that the target communication terminal is not in vicinity of the radio communication device to secure a connection with another target communication terminal within its immediate surroundings.

Regarding claim 2, Hermann discloses a radio communication device or service-consuming device (col. 6, lines 52-67) (Fig. 1A; Fig. 1B) on a network for communicating with a target communication terminal or service-providing device (col. 6, lines 52-67) (Fig. 2A; Fig. 2B) on the network (col. 6, lines 17-46; col. 12, line 58 – col. 14, line 29), comprising:

- a service information memory configured to store service information that corresponds to the target communication terminal so that predetermined functions can be performed with the target communication terminal over the network (col. 13, line 66 - col. 14, line 27);
- a judging module (Fig. 1A, 11) configured to judge whether predetermined disconnection discriminating conditions (e.g. distinguish service-providing devices not within the radio communication device's adjacency) are satisfied by repeating a connection process with the target communication terminal (col. 8, line 58 – col. 9, line 27; col. 13, lines 42-65); and
- a communication control module or CPU (Fig. 1A, 17) configured to invalidate the predetermined functions associated with the service information that corresponds to the target communication terminal and storing the service information in the service information memory when the predetermined disconnection discriminating conditions are satisfied (col. 13, lines 33-51; col. 13, line 66 - col. 14, line 27).

Hermann clearly discloses a radio communication device communicating with a target communication terminal. However, Hermann does not disclose disconnecting radio communication with the target communication terminal.

Hermann discloses judging whether predetermined conditions with the target communication terminal are satisfied with the target communication terminal by repeating a target communication terminal discovery process before disconnecting radio communication

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with the target communication terminal. Wherein, if the target communication terminal is not within the same area as the radio communication device, radio communication is disconnected (col. 3, line 60 – col. 5, line 25; col. 8, line 19 – col. 9, line 27; col. 11, lines 63-67).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the method of Hermann to include disconnecting radio communication with the target communication terminal. One of ordinary skill in the art would have been lead to make such a modification to allow the radio communication device to disconnect communication with the target communication terminal when it is determined that the target communication terminal is not in vicinity of the radio communication device to secure another connection with another target communication terminal within its immediate surroundings.

Regarding claim 10, Hermann discloses a method for controlling a communication device or service-consuming device (col. 6, lines 52-67) (Fig. 1A; Fig. 1B) that exchanges data with a target communication terminal or service-providing device (col. 6, lines 52-67) (Fig. 2A; Fig. 2B) over a network, when a radio communication connection is established between the communication device and a target communication terminal (col. 6, lines 17-46; col. 12, line 58 – col. 14, line 29),

the communication device having a memory for storing various types of data including executed service information (col. 13, line 66 - col. 14, line 27), the method comprising:

judging whether disconnection conditions (e.g. distinguish service-providing devices that are not within the radio communication device's adjacency) are satisfied by repeating a target communication terminal connection process (col. 8, line 58 – col. 9, line 27; col. 13, lines 42-65); and

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invalidating predetermined functions corresponding to the executed service information so that the predetermined functions between the communication device and the target communication terminal can not be performed when disconnection discriminating conditions are satisfied (col. 13, lines 33-51; col. 13, line 66 - col. 14, line 27).

Hermann clearly discloses a radio communication device communicating with a target communication terminal. However, Hermann does not disclose disconnecting radio communication with the target communication terminal.

Hermann discloses judging whether predetermined conditions with the target communication terminal are satisfied with the target communication terminal by repeating a target communication terminal discovery process before disconnecting radio communication with the target communication terminal. Wherein, if the target communication terminal is not within the same area as the radio communication device, radio communication is disconnected (col. 3, line 60 – col. 5, line 25; col. 8, line 19 – col. 9, line 27; col. 11, lines 63-67).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the method of Hermann to include disconnecting radio communication with the target communication terminal. One of ordinary skill in the art would have been lead to make such a modification to allow the radio communication device to disconnect communication with the target communication terminal when it is determined that the target communication terminal is not in vicinity of the radio communication device to secure another connection with another target communication terminal within its immediate surroundings.

Regarding claim 11, Hermann discloses a method for controlling a communication device or service-consuming device (col. 6, lines 52-67) (Fig. 1A; Fig. 1B) that exchanges data with

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target communication terminal or service-providing device (col. 6, lines 52-67) (Fig. 2A; Fig. 2B) over a network (col. 6, lines 17-46; col. 12, line 58 – col. 14, line 29), the communication device having a memory mechanism for storing various types of data (col. 13, line 66 - col. 14, line 27), the method comprising:

registering communication controlling information that defines conditions (e.g. distinguish service-providing devices within the radio communication device's adjacency) for discriminating a radio communication connection established between the communication device and the target communication terminal;

judging whether a radio communication connection between the communication device and a target communication terminal is in a connection status or in a disconnection status, based on the communication controlling information (col. 8, line 58 – col. 9, line 27; col. 13, lines 42-65); and performing radio communications with the target communication terminal by using service information that executes predetermined functions between the communication device and the target communication terminal, the service information being stored in memory based on a discrimination result (e.g. distinguish service-providing devices within the radio communication device's adjacency) (col. 13, lines 33-51; col. 13, line 66 - col. 14, line 27).

Hermann clearly discloses controlling a communication device that exchanges data with a target communication terminal. Hermann does not disclose registering communication controlling information that defines conditions for discriminating between a new radio communication connection established between the communication device and the target communication terminal and a disconnection of radio communication connection established between the communication device and the target communication terminal.

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Hermann discloses discriminating conditions, wherein, if the target communication terminal is not within the same area as the radio communication device, a new target communication terminal or service-providing terminal will be sought to execute predetermined functions (col. 3, line 60 – col. 5, line 25; col. 8, line 19 – col. 9, line 27; col. 11, lines 63-67).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the method of Hermann to include registering communication controlling information that defines conditions for discriminating. One of ordinary skill in the art would have been lead to make such a modification to allow the radio communication device to establish communication with a new target communication terminal when it is determined that the target communication terminal is not in vicinity of the radio communication device to secure a connection with another target communication terminal within its immediate surroundings.

Allowable Subject Matter

13. Claims 4, 6, 7 (depending on claim 6), 8 (depending on claim 6; with objection of claim 8 pending), and 12 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of Hermann, appears to provide discriminating conditions for establishing a connection between a radio communication device and a target communication terminal within the radio communication device rather than allow a user to set up communication conditions of a connection. Therefore, Hermann does not meet the requirements of the claimed invention.

Further, it would be contrary to the teaching in Hermann to modify the prior art to disclose:

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designating a user to set up communication conditions for a newly established radio communication connection with a target communication terminal or for discriminating a disconnection of an existing radio communication connection with a target communication terminal as claimed in claim 4 and a user setting up discriminating conditions for discriminating between establishing a new radio communication connection between a communication device and a target communication terminal and disconnecting a radio communication connection established between the communication device and the target communication terminal as claimed in claim 12

Response to Arguments

14. Any rejections/objections filed on 5-20-2005 not addressed in this action are withdrawn.
15. Applicant's arguments with respect to claims 1-4 and 6-12 have been considered but are moot in view of the new ground(s) of rejection.
16. Accordingly, this action is **NON-FINAL**.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent No. 6,807,413 by Honda discloses a communication interruption occurs and the communication is re-started via a call re-origination operation

18. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

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(571) 273-8300 (for formal communications intended for entry)

Or call:

(571) 272-2600 (for customer service assistance)

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (571) 272-7542. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LH

lh
June 14, 2006


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